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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,892	03/30/2001	David A. Brown	BROWN 4-1-11-1	8909

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EXAMINER

MYERS, PAUL R

ART UNIT	PAPER NUMBER
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2112

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/821,892	Applicant(s) BROWN ET AL.	
	Examiner Paul R. Myers	Art Unit 2112	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-21 is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 8/2/04 have been fully considered but they are not persuasive.

In regards to applicants argument that Arnold does not teach the newly added feature of the protocol indicators being "configured to indicate a particular bus protocol of an external device": The examiner notes in Arnold the external device is the Motorola processor and the Intel processor is configured to use a Motorola protocol to communicate with internal memory allocated to the external Motorola processor. As such the Intel processor is configured to indicate a particular bus protocol of an external device. While the examiner recognizes form applicants arguments that this newly added feature was meant to indicate that the bus protocol was used to communicate with an external device, this however is not what is claimed.

In regards to applicants argument that Szczpanek does not teach the newly added feature: Since Arnold teaches this feature Szczpanek need not teach this feature. However the examiner notes Szczpanek teaches (Column 8 lines 5-20) the processor has the ability to access external memory using the protocol handler which has "the ability to directly access the external memory by using their twenty bit address capabilities." Thus Szczpanek also teaches this feature.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-5 and 8-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Arnold et al PN 6,160,213.

In regards to claims 1 and 8: Arnold et al teaches a multi-protocol (Intel and Motorola) bus system, comprising: a plurality of protocol indicators (address range) associated with an address space (address space), each of said plurality of protocol indicators associated with a segment of said address space (the Intel segment and the Motorola segment See column 12 lines 47-57) and configured to indicate a particular bus protocol (Intel or Motorola); and a bus protocol selection subsystem (the MIDI processor) configured to employ control lines to implement one of said particular bus protocols (See column 12 line 58 to column 13 line 42) in accordance with a selected one of said protocol indicators (addresses) based upon the addressed segment of said address space (Column 13 lines 16 to 42).

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In regards to claims 2 and 9: Arnold et al teaches using the Intel bus protocol. Since the Intel bus protocol includes a chip select signal. Arnold et al inherently teaches the chip select signal.

In regards to claims 3, 4, 10 and 11: Arnold et al teaches an Intel style bus architecture device.

In regards to claims 5, 12: Arnold et al teaches both the Intel and Motorola protocols and since all the claimed signals are either an Intel bus protocol signal or a Motorola bus protocol signal all the claimed signals are taught by Arnold et al.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold et al PN 6,160,213 in view of Szczepanek et al PN 5,715,419.

In regards to claims 6 and 13: Arnold teaches the address segments being in the megabyte sizes as opposed to the claimed 4 kilobyte sizes. Szczepanek et al teaches dividing an address space into 4 kilobyte address ranges. It would have been obvious to a person of ordinary skill in the art at the time of the invention to use the 4 kilobyte address segments of Szczepanek et al in the system of Arnold because this would have allowed for much finer granularity of control.

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6. Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold et al PN 6,160,213 in view of Keene et al PN 5,835,960.

In regards to claims 7, 14: Arnold teaches the address segments being in the megabyte sizes as opposed to the claimed 4 kilobyte size. Arnold also does not teach a PCI bus. Keene et al teaches dividing a PCI address space into 32 kilobyte address ranges. It would have been obvious to a person of ordinary skill in the art at the time of the invention to use the 32 kilobyte address segments of Keene et al in the system of Arnold because this would have allowed for much finer granularity of control.

Allowable Subject Matter

7. Claims 15-21 are allowed.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

PN 6,456,628 to Greim et al teaches a device using the communication protocol of an external device to communicate to the external device.

PN 5,438,663 to Matsumoto et al teaches a device using the communication protocol of an external device to communicate to the external device.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul R. Myers whose telephone number is 703 305 9656. The examiner can normally be reached on Mon-Thur 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on 703 305 4815. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRM
October 7, 2004



PAUL R. MYERS
PRIMARY EXAMINER